

REMARKS/ARGUMENTS

Claims 1-20 are pending.

Claims 1-20 stand rejected.

Claims 3, 4 and 11 have been canceled, without prejudice.

Claims 1, 10 and 17 have been amended. Support for these amendments can be found throughout the specification and drawings, as originally filed.

This response is submitted in response to a Final Office Action. The Applicant submits that the instant response places the application in a condition for allowance, or alternatively, in better form for appeal.

35 USC §112 REJECTION, FIRST PARAGRAPH

Claim 3 is rejected under 35 USC §112, first paragraph, as failing to comply with the enablement requirement.

The Applicant respectfully traverses the 35 USC §112, first paragraph rejection of claim 3.

In the interests of expediting prosecution of the instant application, and without admission that any amendment is necessary, the Applicant has canceled claim 3, without prejudice. Therefore, the 35 USC §112, first paragraph rejection of claim 3 is moot.

35 USC §112 REJECTION, SECOND PARAGRAPH

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Applicant respectfully traverses the 35 USC §112, second paragraph rejection of claims 1-20.

The law is clear that a claim in dependent form shall be construed to incorporate all the limitations of the claim to which it refers. 35 U.S.C. §112 ¶ 4.

In the interests of expediting prosecution of the instant application, and without admission that any amendment is necessary, the Applicant has canceled claims 3, 4 and 11, without prejudice. Therefore, the 35 USC §112, second paragraph rejection of claims 3, 4 and 11 is moot.

In the interests of expediting prosecution of the instant application, and without admission that any amendment is necessary, the Applicant has amended claims 1, 10 and 17 to remove the allegedly indefinite language.

Therefore, the 35 USC §112, second paragraph rejection of claims 1 and 10 has been overcome and these claims are now in a condition for allowance. Further, claims 2 and 5-9, which depend from and further define claim 1, are likewise allowable. Additionally, claims 12-16, which depend from and further define claim 10, are likewise allowable. Finally, claims 18-20, which depend from and further define claim 17, are likewise allowable.

35 USC §103(a) REJECTION

Claims 1-7, 10-14, 17 and 20 stand rejected under 35 USC §103(a) as being unpatentable over U.S. Patent No. 3,711,999 to Held, in view of U.S. Patent No. 4,978,254 to Langlois et al.

The Applicant respectfully traverses the 35 USC §103(a) rejection of claims 1-7, 10-14, 17 and 20

The standard for obviousness is that there must be some suggestion, either in the reference or in the relevant art, of how to modify what is disclosed to arrive at the claimed invention. In addition, "[s]omething in the prior art as a whole must suggest the desirability and, thus, the obviousness, of making" the modification to the art suggested by the Examiner. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 U.S.P.Q.2d (BNA) 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988). Although the Examiner may suggest the teachings of a primary reference could be modified to arrive at the claimed subject matter, the modification is not obvious unless the prior art also suggests the desirability of such modification. *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d (BNA) 1397, 1398 (Fed. Cir. 1989). There must be a teaching in the prior art for the proposed combination or modification to be proper. *In re Newell*, 891 F.2d 899, 13 U.S.P.Q.2d (BNA) 1248 (Fed. Cir. 1989). If the prior art fails to provide this necessary teaching, suggestion, or incentive supporting the Examiner's suggested modification, the rejection based upon this suggested modification is error and must be reversed. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d (BNA) 1566 (Fed. Cir. 1990).

In the interests of expediting the prosecution of the instant application, and without admission that any amendment is necessary, the Applicants have amended

claim 1 to recite, among other things, a rotary edging wheel comprising: (1) a hub portion adapted for attachment to a rotary power source; (2) an outer circumferential cutting surface having a width, said surface including an abrasive grit attached thereto, wherein said surface is substantially planar; (3) a radially extending planar side portion; and (4) at least one swarf clearing groove extending at an angle across the entire width of said surface and opening into said planar side portion, said swarf clearing groove operable to remove swarf out through said planar side portion, wherein said surface is operable for edge finishing of an optical lens.

In the interests of expediting the prosecution of the instant application, and without admission that any amendment is necessary, the Applicants have amended claim 10 to recite, among other things, a rotary edging wheel comprising: (1) a hub portion adapted for attachment to a rotary power source; (2) an outer circumferential cutting surface having a width, said surface including an abrasive grit attached thereto, and having a circumferential groove therein for forming an edge contour onto an optical lens, wherein said surface is substantially planar; (3) a radially extending planar side portion; and (4) a plurality of swarf clearing grooves extending at an angle across the entire width of said surface and opening into said planar side portion, said swarf clearing grooves operable to remove swarf out through said planar side portion, wherein said surface is operable for edge finishing of an optical lens.

In the interests of expediting the prosecution of the instant application, and without admission that any amendment is necessary, the Applicants have amended claim 17 to recite, among other things, a rotary bevel edging wheel comprising: (1) a hub portion adapted for attachment to a rotary power source; (2) an outer

circumferential cutting surface having a width, said surface including an abrasive grit attached thereto, and having a circumferential groove therein for forming an edge contour onto an optical lens, wherein said surface is substantially planar; (3) a radially extending planar side portion; and (4) a plurality of swarf clearing grooves extending across the entire width of said outer circumferential cutting surface, at an angle of from about 35 to about 45 degrees to said planar side portion and opening into said planar side portion, said swarf clearing grooves operable to remove swarf out through said planar side portion, wherein said surface is operable for edge finishing of an optical lens.

Neither Held nor Langlois et al., either alone or in combination therewith, suggest such structures as recited in any of claims 1, 10 and/or 17.

Held does not disclose any swarf-clearing grooves in an outer cutting surface of a grinding wheel, and especially swarf-clearing grooves that extend along the entire width of the side surfaces of the grinding, and more especially swarf-clearing grooves that extend along the entire width of the side surfaces of the grinding wheel at specific angles. The notches disclosed by Held are merely for air-cooling purposes and not for material removal purposes. Assuming *arguendo* that the notches disclosed by Held were capable of performing a swarf clearing function, they would not be able to simultaneously perform the intended air-cooling function required by Held, as the accumulating swarf material would undoubtedly defeat the air-cooling function of the grooves.

The Examiner correctly noted that Held fails to disclose that the cutting surface is operable for edge finishing of an optical lens. Apparently, the Examiner cited Langlois

et al. to cure the deficiencies in the disclosure of Held. However, Langlois et al. includes several deficiencies, as well.

Initially, Langlois et al. disclose a cutting surface that is not planar, as the instant claims require, but rather one that includes several three-dimensional raised tooth portions 3. Additionally, the recess portions 8 do not extend along the entire width of the cutting surface, as the instant claims require, but rather are centered along the cutting surface adjacent to the tooth portions 3. In fact, Langlois et al. is completely silent regarding the purpose of the recess portions 8, i.e., there is no disclosure regarding swarf clearance at all.

Accordingly, there is no motivation to combine the disclosures of Held and Langlois et al. to suggest the claimed invention. As noted, Held merely discloses a grinding wheel with a primary emphasis on air-cooling and is completely silent regarding swarf removal in connection with optical lens. Langlois et al. arguably disclose a grinding wheel for optical lens; however, it is completely silent regarding swarf removal and furthermore teaches away from the claimed invention by its use of raised cutting surfaces.

Thus, if one of ordinary skill in the art were attempting to construct a rotary edging wheel, as presently claimed, they most certainly would not look to either Held and/or Langlois et al., either alone or in combination therewith, for any guidance.

Accordingly, the Applicants submit that claims 1, 10 and 17 are not unpatentable over Held and/or Langlois et al., either alone or in combination therewith.

Therefore, the 35 USC §103(a) rejection of claims 1, 10 and 17 has been overcome and these claims are now in a condition for allowance. Further, claims 2 and

5-7, which depend from and further define claim 1, are likewise patentable over Held and/or Langlois et al., either alone or in combination therewith, for at least the reasons set forth above. Claims 12-14, which depend from and further define claim 10, are likewise patentable over Held and/or Langlois et al., either alone or in combination therewith, for at least the reasons set forth above. Claim 20, which depends from and further define claim 17, is likewise patentable over Held and/or Langlois et al., either alone or in combination therewith, for at least the reasons set forth above.

35 USC §103(a) REJECTION

Claims 8, 9, 15, 16, 18, and 19 are rejected under 35 USC §103(a) as being unpatentable over U.S. Patent No. 3,711,999 to Held, in view of U.S. Patent No. 5,997,597 to Hagan.

The Applicants respectfully traverse the 35 USC §103(a) rejection of claims 8, 9, 15, 16, 18 and 19.

The Applicants submit that Held does not render independent claims 1, 10 and 17 obvious for at least the reasons set forth above. The Examiner apparently cited Hagan to cure the deficiencies in the teachings of Held.

Hagan does not disclose or suggest, among other things, a rotary edging wheel that is operable to edge finish an optical lens, wherein the cutting surface is substantially planar and is provided with grooves for swarf removal. While Hagan arguably discloses that an abrasive material can be disposed on a grinding surface, it appears to teach away from the claimed invention, in that it teaches that the abrasive tool is particularly well-suited to heavy duty grinding applications involving metal,

concrete, stone, ceramics and the like, as opposed to relatively delicate operations such as edge finishing of an optical lens.

Thus, if one of ordinary skill in the art were attempting to construct a rotary edging wheel, as presently claimed, they most certainly would not look to either Held and/or Hagan, either alone or in combination therewith, for any guidance.

Thus, independent claims 1, 10 and 17 are patentable over Held and/or Hagan, either alone or in combination therewith, for at least the reasons set forth above. Claims 8 and 9, which depend from independent claim 1, further define the claimed invention and are likewise patentable over Held and/or Hagan, either alone or in combination therewith, for at least the reasons set forth above. Claims 15 and 16, which depend from independent claim 10, further define the claimed invention and are likewise patentable over Held and/or Hagan, either alone or in combination therewith, for at least the reasons set forth above. Claims 18 and 19, which depend from independent claim 17, further define the claimed invention and are likewise patentable over Held and/or Hagan, either alone or in combination therewith, for at least the reasons set forth above.

Accordingly, the Applicant submits that the 35 U.S.C. §103(a) rejection of claims 8, 9, 15, 16, 18 and 19 has been overcome.

CONCLUSION

In view of the foregoing, the Applicant respectfully requests reconsideration and reexamination of the Application. The Applicant respectfully submits that each item raised by the Examiner in the Final Office Action of June 3, 2004 has been successfully traversed, overcome or rendered moot by this response. The Applicant respectfully

submits that each of the claims in this Application is in condition for allowance and such allowance is earnestly solicited.

The Examiner is invited to telephone the Applicant's undersigned attorney at (248) 364-4300 if any unresolved matters remain.

Any needed extension of time is hereby requested with the filing of this document.

The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-1612. A duplicate copy of this letter is enclosed herewith.

Respectfully submitted,

WARN, HOFFMANN, MILLER & LALONE, P.C.
Attorneys for Applicant(s)

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By: 

Philip R. Warn (Reg. No. 32775)
Preston H. Smirman (Reg. No. 35365)

P.O. Box 70098
Rochester Hills, Michigan 48307
Telephone: (248) 364-4300
Fax: (248) 364-4285